

CLAIM REJECTIONS

REMARKS

Claim 3 is withdrawn as being directed to a non-elected invention. Claims 6-23 are pending. No new matter has been added as a result of the amendments.

Elections/Restrictions

The instant Office Action states that the present Application contains two inventions related as combination and sub-combination. As such, the Applicants are required to elect an invention for examination. According to the instant Office Action, the Applicants are required to elect between Invention I and Invention II.

Applicants elect without traverse Invention II. According to the Examiner, claims 6-23 are drawn to Invention II.

35 U.S.C. §103 Rejections

Claims 6-9, 11-14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (US PAT 6285987), hereinafter referred to as Roth, in view of Gross et al. (US PAT 5283856), hereinafter referred to as Gross. Claims 10, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth, Gross, and Binder (US PAT 6513052). Claims 15, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth, Gross, and Klayh (US PAT APP 2003/0103644). Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Roth, Gross, and Dentel et al. (US PAT 7062451).

The Examiner is respectfully directed to previously presented independent

Claim 6, which recites a rules evaluation system for a user's computer comprising:

a rules-based agent having a plurality of rules clauses for evaluating data, wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses;

at least one targeted advertising trigger having functionality to notify the rules-based agent to begin evaluating;

a plurality of data providers to provide data for evaluation; and

at least one action for providing information to a user based upon the evaluated data, wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied, and wherein at least one of said at least one action comprises communicating with said user by displaying a user prompt associated with said target advertising triggers, and wherein said user prompt leads to a sale(emphasis added).

Claims 7-23 depend from currently amended independent Claim 6 and recite further limitations of the claimed invention. Applicant respectfully asserts that the claimed invention is neither shown nor suggested by the Roth reference or the Gross reference alone or in combination.

Applicant respectfully asserts that Roth fails to teach, suggest, or render obvious " a rules-based agent having a plurality of rules clauses for evaluating data, wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses; at least one targeted advertising trigger having functionality to notify the rules-based agent to begin evaluating; a plurality of data providers to provide data for evaluation; and at least one action for providing information to a user based upon the evaluated data, wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied, and wherein at least one of said at least one action comprises communicating with said user by displaying a user prompt associated with said target advertising triggers, and wherein said user prompt leads to a sale," as recited in Claim 6.

Roth and the claimed invention are very different. Roth appears to be

directed towards providing (and selling) advertisement from a central server.
(Col 2, lines 1-10)

Roth does not teach a rules evaluation system evaluating data associated with a user's computer and automatically generating a targeted advertisement that leads to a sale (e.g., a sale of a product needed by the user's computer).

The Examiner, in the instant Office Action, has specifically cited col.9, lines 15-16 of Roth as teaching "wherein said user prompt leads to a sale." as recited in Claim 6. Col. 9, lines 15-16 of Roth recites "Website: A term conventionally used in connection with the World Wide Web. Usually an Ad space provider (seller)."

Clearly then, as the Examiner has pointed out, Roth is limited to an Ad space provider that sells advertisement spaces on the World Wide Web (WWW). As such, Applicants respectfully assert that "Website: A term conventionally used in connection with the World Wide Web. Usually an Ad space provider (seller)." (col. 9, lines 15-16 of Roth) does not teach "wherein said user prompt leads to a sale." as recited in Claim 6.

Applicant respectfully asserts that Roth fails to teach, suggest, or render obvious a rules evaluation system for a user's computer. In particular, Roth fails to teach "at least one action for providing information to a user based upon the evaluated data, wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied, and wherein at least one of said at least one action comprises communicating with said user by displaying a user prompt associated with said target advertising triggers, and wherein said user prompt leads to a sale." as recited in Claim 6.

Applicants agree with the Examiner that Roth fails to disclose, teach, suggest, or render obvious "wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses;...at least one action for providing information to a user based upon the evaluated data, wherein an action is performed provided all of the required rules clauses and at least one

of the optional rules clauses are satisfied." The Examiner alleges that Gross cures this defect of Roth.

Among other defects of Gross, Applicant respectfully asserts that the combination of Gross and Roth is improper. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680. Again, Roth is directed at systems "for providing advertisements from a central server to viewers who access web sites." (col. 1, lines 65 – col. 2, lines 5, Roth) In contrast, Gross is directed towards a rule based system for directing electronic mail. (col. 1, lines 1-5, Gross).

As discussed in MPEP §2143, Applicants respectfully assert that no suggestion or motivation to combine Roth and Gross in the claimed fashion has been shown sufficiently to establish a prima facie case of obviousness. Applicants respectfully assert that neither Roth nor Gross, either explicitly or inherently, provide a motivation or suggestion to combine the two references in the claimed fashion. Applicants respectfully request the Examiner to produce specific authority in Roth or Gross that provides a motivation to combine Roth and Gross.

Furthermore, Applicant respectfully asserts that Gross, Binder, Klayh, and Dentel, alone or in combination, do not overcome the shortcomings of the Roth reference. Gross, Binder, Klayh, and Dentel, alone or in combination, also do not teach or suggest "a rules-based agent having a plurality of rules clauses for evaluating data, wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses; at least one targeted advertising trigger having functionality to notify the rules-based agent to begin evaluating; a plurality of data providers to provide data for evaluation; and at least one action for providing information to a user based upon the evaluated data, wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied, and wherein at least one of said at least one action comprises communicating with said user by displaying a user prompt associated with said target advertising

triggers, and wherein said user prompt leads to a sale." (emphasis added).

Thus, for at least this reason, Applicant respectfully reasserts the Roth reference alone or in combination with Gross, Binder, Klayh, and Dentel do not teach the present claimed invention.


Therefore, Claim 6 is in condition for allowance. Therefore, for at least these reasons, Claims 7-23 overcome the Examiner's prior basis for rejection under 35 U.S.C. 103(a) at least for being dependent on an allowable base claim.

Conclusion

In view of the foregoing remarks, the Applicant respectfully submits that the pending claims in the instant patent application are in condition for allowance. The Applicant respectfully requests reconsideration of the Application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact James Hao at the below listed phone number.

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